REMARKS

Claims 1-24 are pending in the application and all stand rejected. The drawings have been objected to by the Examiner. Claims 1, 11, 17, and 21 are amended.

Reconsideration and allowance of claims 1-24 is respectfully requested in view of the following:

Drawings

The drawings are objected to because the reference character 625 (Main Memory) in Figure 2 is mentioned in the description as reference character 125. Corrected drawing sheet 2 of 4 correcting Figure 2 is attached as Appendix A. Therefore, this objection should be withdrawn.

Response to Rejections to Claims – 35 U.S.C. §112

Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejections of independent claims 1, 11, 17, and 21 all state on page 3 of the Office Action the phrase "*unstable* state." However, it is believed that the rejections *should* state the phrase "*unusable* state." Therefore, this amendment responds accordingly.

Independent claims 1, 11, 17, and 21 have all been amended to replace the second reference in each of the independent claims of "an unusable state" in the claim to read "*the* unusable state." Therefore, it is clear that the second reference in each claim refers to the first reference in each claim. As such, these rejections should be withdrawn. It is submitted that these amendments are NOT limiting the scope of the claims, but rather are modifications improving the form of the claims and thus avoid prosecution history estoppel under the commonly known Festo case.

Responses to Rejections to Claims – 35 U.S.C. §102

Claims 1, 2, 11, 13-15, 17, 19-21 and 23-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Park (U.S. Patent No. 6,418,536) (Park hereinafter). This rejection is not applicable to the amended claims.

Amended claims 1 and 11 each recite, among other things, "analyzing the sensed information to determine if the IHS is currently in an unusable state; and entering a reduced power mode, by the IHS, if it is found that the IHS is currently in the unusable state." Similarly, Amended claims 17 and 21 each recite, among other things, "nonvolatile storage, coupled to the

processor, for storing control software for analyzing the sensed information to determine if the portable IHS is currently in an unusable state and for causing the portable IHS to enter a reduced power mode if it is found that the portable IHS is currently in the unusable state."

However, the USPTO provides MPEP §2131 that: "To anticipate a claim, the reference must teach every element of the claim."

Therefore, to support these rejections with respect to claims 1, 2, 11, 13-15, 17, 19-21 and 23-24 Park must contain all of the above-claimed elements. However, this patent does not disclose "analyzing the sensed information to determine if the IHS is currently in an unusable state; and entering a reduced power mode, by the IHS, if it is found that the IHS is currently in the unusable state" or "nonvolatile storage, coupled to the processor, for storing control software for analyzing the sensed information to determine if the portable IHS is currently in an unusable state and for causing the portable IHS to enter a reduced power mode if it is found that the portable IHS is currently in the unusable state" as recited in the independent claims 1, 11, 17, and 21.

The rejection states on page 4 that Park teaches the above-recited claim elements in Col. 5, lines 40-54, Col. 6, lines 8-16, and Col. 7, lines 19-36. However, reviewing these reference locations reveals that Park instead teaches turning off an LCD backlight if a user *who is using the computer* is in the vicinity of the computer or has left the vicinity of the computer. In fact, a quick search of the entire Park patent reveals that neither of the terms "usable" or "unusable" are even found in the patent. Additionally, Park states that "there is a need in the portable computer art [for] a . . . power saving function . . . *during computer use* regardless of the power management setup condition." Col. 2, lines 1-4. Emphasis added. Park goes on to state "[t]he present invention is intended to . . . provide a portable computer which can perform an instant power saving function in response to absence of the computer user *during use* of the computer. Col. 2, lines 7-11. Emphasis added. Furthermore, Park states that the sensing device 20 for sensing user proximity is located in top portion of the flat panel display 6 where the display 6 is "facing a computer user *in the open or use position* and forms a lid covering the keyboard 9 of the main body in the close position. Col. 3, lines 4-10. Emphasis Added. Thus, the function of Park is lost in a closed or unusable state. Hence, the computer of Park MUST BE IN A USABLE STATE (open, facing up, in a lighted room, not being moved from place to place, etc.) to function.

Thus, Park is not disclosing, teaching, or suggesting an "unusable state" as defined in the present application and recited in the pending claims. Rather, Park requires the computer

be in an open or use position. As a result, the previous rejections based on 35 U.S.C. 102(b) cannot be supported by Park as applied to independent claims 1, 11, 17, and 21.

Claims 2-10 depend directly or indirectly from independent claim 1 and are allowable as depending from an allowable claim.

Claims 12-16 depend directly or indirectly from independent claim 11 and are allowable as depending from an allowable claim.

Claims 18-20 depend directly or indirectly from independent claim 17 and are allowable as depending from an allowable claim.

Claims 22-24 depend directly or indirectly from independent claim 21 and are allowable as depending from an allowable claim.

Responses to Rejections to Claims – 35 U.S.C. §103

Claims 3-10, 12-13, 16, 18-19 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park (U.S. Patent No. 6,418,536) (Park hereinafter) in view of Barrett (U.S. Patent No. 6,782,471) (Barrett hereinafter). This rejection is not applicable to the amended claims.

Each of these claims, 3-10, 12-13, 16, 18-19 and 22-23, depend directly or indirectly from one of independent claims 1, 11, 17, or 21. As shown above, independent claims 1, 11, 17, and 21 are each allowable. Therefore, claims 3-10, 12-13, 16, 18-19 and 22-23 are allowable as depending from an allowable claim. Thus, this rejection should be withdrawn.

There are other mutually exclusive reasons for the allowability of claims 3-10, 12-13, 16, 18-19, and 22-23. Amended claims 1 and 11 each recite, among other things, "analyzing the sensed information to determine if the IHS is currently in an unusable state; and entering a reduced power mode, by the IHS, if it is found that the IHS is currently in the unusable state." Similarly, Amended claims 17 and 21 each recite, among other things, "nonvolatile storage, coupled to the processor, for storing control software for analyzing the sensed information to determine if the portable IHS is currently in an unusable state and for causing the portable IHS to enter a reduced power mode if it is found that the portable IHS is currently in the unusable state."

As the PTO recognizes in MPEP §2142:

> The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the <u>subject</u> <u>matter</u> <u>as</u> <u>a</u> <u>whole</u> would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, <u>all limitations of the claim</u> <u>must be evaluated</u>. However, the references, alone, or in any combination, do not teach "analyzing the sensed information to determine if the IHS is currently in an unusable state; and entering a reduced power mode, by the IHS, if it is found that the IHS is currently in the unusable state" or "nonvolatile storage, coupled to the processor, for storing control software for analyzing the sensed information to determine if the portable IHS is currently in an unusable state and for causing the portable IHS to enter a reduced power mode if it is found that the portable IHS is currently in the unusable state" as recited in the independent claims 1, 11, 17, and 21.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Recently, the Supreme Court ruled that the "teaching, suggestion, or motivation (TSM) test" for determining obviousness still applies, but should be used in a more "expansive and

flexible" manner. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. __, 11 (2007). The Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." Id. at 14-15.

In the present case, the Examiner has not expressed a reason why a person of ordinary skill in the art would combine the teachings of Park with the teachings of Barrett, as required by claims 3-10, 12-13, 16, 18-19 and 22-23. The Park reference teaches a power saving function *during computer use* (see Col. 2, lines 1-4, emphasis added). The Barrett reference teaches device monitoring during an inactive state to transition the device *from an inactive state to an active state* (i.e. to a use state) (see Col. 1, lines 48-64, emphasis added). If the benefits of Park are combined with the benefits of Barrett, as suggested by the Examiner, the result would not be the benefits of the claim, as is required by the pending claims. Pending independent claims 1 and 11 combine analyzing the sensed information to determine if the IHS is currently in an unusable state with entering a reduced power mode, by the IHS, if it is found that the IHS is currently in the unusable state. Similarly, pending claims 17 and 21 combine nonvolatile storage, coupled to the processor, for storing control software for analyzing the sensed information to determine if the portable IHS is currently in an unusable state and for causing the portable IHS to enter a reduced power mode if it is found that the portable IHS is currently in the unusable state, which the suggested combination cannot achieve because the suggested combination would result in monitoring a device or a user of the device during or before the *use of the device*. In view of the above, a person of ordinary skill in the art would not have a reason to combine Park with Barrett. Therefore, there is simply no basis for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

Thus, in the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any reason why a person of ordinary skill in the art would combine the references as required by the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly

cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claim(s) 1, 11, 17, and 21 and their respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of claims 1-24 is respectfully requested.

The amended claims are supported by the original application.

Conclusion

This is an earnest attempt to put all claims in proper form for immediate allowance. In view of all of the above, the allowance of claims 1-24 is respectfully requested. The amended claims are supported by the original application.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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